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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,216	10/27/2000	Patrick Potega		8292

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EXAMINER	
VERBITSKY, GAIL KAPLAN	
ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/699,216	POTEGA, PATRICK	
	Examiner	Art Unit	
	Gail Verbitsky	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07/17/2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-117* is/are pending in the application.

4a) Of the above claim(s) *19-99* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *100-117* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *19-99* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Restriction by Original Presentation

1. Newly submitted claims 19-99 are directed to an apparatus for enabling multiple modes, etc., that is independent or distinct from the invention originally claimed for the following reasons:

a) the originally claimed invention, i.e., claims 1-18, now claims 100-117, is directed to an apparatus for monitoring temperature functions of a power source.

b) the invention stated in claims 19-99 is not directed to monitoring temperature functions,

c) the originally claimed invention is classified in class 374, subclass 185.

d) the invention stated in new claims 19-99 is classified in class 429.

Since Applicant has received an action on the merits (01/24/2002 and 03/17/2004) for the originally presented invention, this invention (claims 100-117) has been constructively elected by original presentation for further prosecution on the merits. Accordingly, claims 19-99 are withdrawn from consideration as being directed to non-elected invention. See 37 CFR and MPEP 821.03.

Claim Objections

2. Claims 100-102, 105-106, 111, 113-114 are finally objected to because of the following informalities:

Claim 100: A) perhaps applicant should replace "an insulator" in line 3 with –a first insulator--,

B) perhaps applicant should replace "the" before "non-deposited" in line 5 with

–another,--,

C) perhaps applicant should insert –a—before "part" in lines 8 and 9,

D) perhaps applicant should replace "At least" in line 9 with –at least—because only the very first letter of the claim can be capitalized,

E) perhaps applicant should replace "the ink film" in line 13 with –said ink film—in order to maintain consistency through the claim,

F) perhaps applicant should replace "said ink" in line 14 with –said ink film—in order to maintain consistency through the claim,

G) it is not clear from the claim how the power flowing "detects an altered resistive characteristics of said ink" as stated in claim 100.

Claim 101: A) perhaps applicant should replace "said first layer" in line 2 with –said first insulator layer--, in order to clearly describe the invention,

B) perhaps applicant should replace "said ink deposition" in line 3 with –said ink film—in order to maintain consistency through the claim,

Claim 102: perhaps applicant should replace "said ink" in line 1 with –said ink film—in order to maintain consistency through the claim,

Claim 105: perhaps applicant should replace "said insulator layer" in line 1 with –said first insulator layer--, in order to clearly describe the invention,

Claim 106: "the exterior" in line 2 lacks antecedent basis. Perhaps applicant should replace "the exterior" in line 2 with –an exterior surface, for a proper antecedent basis and in order to clearly describe the invention,

Claim 111: perhaps applicant should replace "The conforming of claim 105, further comprising the attaching means" in line 1 with –The apparatus of claim 105, wherein the attaching means--, since "an attaching means" lacks antecedent basis (see claim 100).

Claim 113: "The connector element" in line 1 lacks antecedent basis. Perhaps applicant should replace "The connector element of claim 108" with –The apparatus of claim 108, wherein the multi-conductor connector--,

Claim 114: "said enabling means" in line 1 lacks antecedent basis. Perhaps applicant should replace it with –said interconnecting means--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 100, 116 are finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case,

Claim 100: it appears that "thermally-reactive ink" has not been described in the specification,

Claim 116: it appears that the limitation including "each segment separately monitors the specific surface area" has not been described in the specification.

Claims 101-115 are rejected by virtue of their dependency on claim 100.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 117 is finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case,

A) ""being attached to an accessible surface area of a plurality power sources" in lines 2-3 makes the claim language confusing because it is not clear if the apparatus is attachable to a plurality of the power sources at the same time, or applicant means that the apparatus is attachable/ can accommodate to shapes of (differently shaped) plurality of the power sources (not at the same time).

B) "a plurality of temperature-monitoring functions" in lines 8-9 makes the claim language confusing because it is not clear what is a plurality of temperature-monitoring functions? It appears that a temperature-monitoring function is only one function, the function of monitoring temperature. Does applicant means plurality temperature measurements, i.e., over time? Clarification is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 100, 116 are finally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6152597 [hereinafter Patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Patent, in claims 1-2, claims all the limitations claimed by the applicant in the instant application.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 117 is finally rejected (as best understood by the Examiner) under 35 U.S.C. 103(a) as being unpatentable over Friel.

Friel discloses in Fig. 1 a device comprising insulation layers/ non-conductive strata (col. 3, lines 55-56) for sandwiching two resistive elements 3 and 4 having conductive elements 5 and 6 positioned upon a resistive element (comprising conductive ink, col. 5, lines 30-31) 2 and constituting two segments on top of the

element 2, the conductive electrodes (connectors) sharing an adjacent (common) segment 2 and the resistive elements 3 and 4 are accessible through these conductive electrodes (elements).

It has been held that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute limitations in any patentable sense. In re Hutchinson, 69 USPQ 138.

With respect to "whereby"/"thereby", as stated in the claim: it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957).

With respect to the preamble of claim 117: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

Allowable Subject Matter

11. Claims 100-115 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments with respect to claims 100-117 have been considered but are moot in view of the new ground(s) of rejection necessitated by the present amendment.

Applicant states that the continuous film of the present invention is of a specific geometric configuration (parallelogram) different from Friel and Cataldi. Applicant states that each segment of the area ink defines an independent thermistor, not taught by Friel and Cataldi. These arguments are not persuasive because these limitations are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specification that are anticipated or unpatentable. Constant v. Advanced Micro-Devices, Inc., 7 USPQ2d 1064.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

Gail Verbitsky
Primary Patent Examiner, TC 2800

October 27, 2004